REMARKS

In view of the amendments proposed above, Applicants respectfully request consideration of the following remarks.

Anticipation Rejections Under 35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Anticipation Rejection Based on United States Patent 5,960,350 to Schorman et al.

Claims 1-4, 6, 7, 10-13, 15, 16, 19-27, 29, 30, 33-36, 38, 39, and 42-46 were rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent 5,960,350 to Schorman et al. (hereinafter "Schorman"). Applicants respectfully traverse this rejection as set forth below.

Some of the embodiments disclosed in the present application are directed to a method (and system) for determining downlink weights that employs existing subscriber unit feedback mechanisms and, in particular, that takes advantage of pilot channels not normally used by a base station communicating with a subscriber unit. Specification, at page 8. More specifically, these embodiments make use of "test pilot" channels. Specification, at page 11. A "test pilot" channel comprises a pilot channel (e.g., a CDMA pilot channel) that is not normally used by a base station when communicating with a

subscriber unit (i.e., a pilot signal associated with one of a number of other base stations in the system). *Id.* Generally, a pilot channel is uniquely associated with one base station. Specification, at page 8. Because a subscriber unit is not in range with all other base stations in the system at any given time, or because other base stations in the system are not in use, there will be a number of pilot channels that may be used by the base station communicating with the subscriber unit (each of these pilot channels comprising a pilot channel associated with another base station and not normally used by the base station – i.e., a "test pilot" channel). Specification, at page 11.

Each of independent claims 1, 10, 19, 24, 33, and 42 has been amended to recite this novel use of "test pilot" channels. For example, claim 1, as amended, recites:

> 1. A method to determine an antennae array weight set corresponding to a subscriber unit (SU) for cellular communications between the SU and a first base station (BS) of a system, ***the system including the first BS and a number of other base stations***, the method comprising:
>
> transmitting a plurality of test pilot downlink signals from the first BS to the SU, each test pilot downlink signal processed with a different weight set than the other test pilot downlink signals, each test pilot downlink signal comprising a CDMA pilot signal ***associated with one of the other base stations***;
>
> receiving a report signal from the SU for at least one of the test pilot downlink signals; and
>
> selecting a weight set from the plurality of weight sets based, at least in part, on the received report signal.

Each of independent claim 10, 19, 24, 33, and 42 has been amended to include limitations similar to those recited in independent claim 1.

Schorman does not disclose at least the claimed feature of using a "test pilot downlink signal" wherein the test pilot signal comprises a pilot signal (e.g., a CDMA pilot signal) that is "associated with one of the other base stations" in the system. Rather, Schorman discloses a base station that uses a beacon signal that is that same as that base station's pilot signal, but with a different PN offset. *See* Schorman, at Column 5, Lines 42-58, and Final Office Action, at page 6 (where it is stated "Schorman discloses the base station which uses a test pilot signal which has a different PN offset with its assigned pilot signal"). Accordingly, Schorman fails to disclose each and every limitation of independent claims 1, 10, 19, 24, 33, and 42, respectively and, therefore, each of these claims is novel in view of Schorman.

In addition, claims 2, 3, 4, 6, and 7 are allowable as depending from novel independent claim 1; claims 11, 12, 13, 15, and 16 are allowable as depending from novel independent claim 10; claims 20-23 are allowable as depending from novel independent claim 19; claims 25, 26, 27, 29, and 30 are allowable as depending from novel independent claim 24; claims 34, 35, 36, 38, and 39 are allowable as depending from novel independent claim 33; and claims 43-46 are allowable as depending from novel independent claim 42.

Obviousness Rejections Under 35 U.S.C. § 103

To reject a claim or claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. M.P.E.P. § 2142. When establishing a prima facie case of obviousness, the Examiner must set forth evidence showing that the following three criteria are satisfied:

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). Also, the evidentiary showing of a motivation or suggestion to combine prior art references "must be clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Obviousness Rejection Based on United States Patent 5,960,350 to Schorman et al.

Claims 5, 8, 9, 14, 17, 18, 28, 31, 32, 37, 40, and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schorman. Applicants respectfully traverse this rejection as set forth below.

As set forth above, Schorman fails to disclose all limitations of each of independent claims 1, 10, 24, and 33; therefore, each of these claims is nonobvious in

view of Schorman. If an independent claim is nonobvious, then any claim depending from the independent claim is also nonobvious. M.P.E.P. §2143.03 (citing *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)). Therefore, claims 5, 8, and 9 are allowable as depending from nonobvious independent claim 1; claims 14, 17, and 18 are allowable as depending from nonobvious independent claim 10; claims 28, 31, and 32 are allowable as depending from nonobvious independent claim 24; and claims 37, 40, and 41 are allowable as depending from nonobvious independent claim 33.

CONCLUSION

Applicants submit that claims 1-46 are in condition for allowance and respectfully request allowance of such claims.

Please charge any shortages and credit any overages to our Deposit Account No. 02-2666.

Respectfully submitted,

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